



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,353	06/01/2001	Brian R. McCarthy	310048-550	3630

7590 02/22/2005

Douglas N Larson Esq
Squire Sanders & Dempsey LLP
801 S Figueroa St 14th Floor
Los Angeles, CA 90017-5554

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,353

Applicant(s)

MCCARTHY ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 166-168, 207-209 and 224-272 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 166-168, 207-209 and 224-272 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/3/04, 2/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 166-168, 207-209 and 224-272 are pending in the application, claims 1-165, 169-206 and 210-223 have been cancelled.
2. Amendments to the claims, filed on November 2, 2004, have been entered in the above-identified application.
3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 234-275 been renumbered 231-272.

REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Objections

5. Applicant is advised that should claim 263 be found allowable, claim 266 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

Art Unit: 1772

despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

6. Claims 227-272 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 227, among other claims, contains the limitation “carrier sheet.” The specification does not mention “carrier sheet,” and therefore this limitation is considered new matter. It is noted that Applicant does have support for limitations such as liner sheet, base paper and base material (*specification page 13, paragraph 74*).

The new matter must be deleted.

7. Claim 250 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claim 250 contain(s) the limitations “butt-cut columns” and “butt-cut rows.” The specification does not mention “butt-cut” and therefore these limitations are considered new matter.

The new matter must be deleted.

Art Unit: 1772

8. Claims 254, 255 and 270 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 254 recites the limitation "the thin end" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 254 is dependent on 256 renumbered 253. Claim 253 does not recite any limitations directed to a thin end.

Claim 255 recites the limitation "the thin end" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 254 is dependent on 256 renumbered 253. Claim 253 does not recite any limitations directed to a thin end.

Claim Rejections - 35 USC § 102

9. Claims 166, 207, 224, 227-232, 234, 236-241, 244-248, 250, 252, 253, 256, 257, 259, 262, 265, 270, 271 and 272 are rejected under 35 U.S.C. 102(b) as being anticipated by Viby (WO 95/34879).

Viby discloses a label system readily employed for providing a multitude of labels or tags such as place cards, visiting card, gift tokens, taking in to dinner-cards, name signs, conference signs or badges, table signs and identity cards (*page 2, lines 14-18*).

Regarding Applicant's claims 166, 207 and 224, Viby discloses a sheet of printable business cards (*labels, page 1, line 37 through page 2, line 5*) comprising a card stock sheet construction (*printing paper, page 4, line 35*) and a solid continuous liner sheet (*support sheet, page 4, line 32 and page 6, lines 1-3*) releasably secured with ultraremovable adhesive (*adhesive*

Art Unit: 1772

coating, page 4, lines 19-25) to and covering the backside of the cardstock sheet construction (page 3, lines 27-28, page 4, lines 35-38 and figure 1).

Viby's adhesive coating is deemed to be ultraremovable because it is a water based acrylic adhesive (*page 4, lines 24-25*), which is one of the preferred adhesives applicant discloses (*specification page 25, paragraph 104*). It is further deemed to be an ultraremovable adhesive because, as discussed later, the adhesive remains on the carrier sheet and is not permanently attached to the card stock sheet construction.

Viby's support sheet is deemed to be a solid continuous liner sheet, since the reference discloses that the support sheet is a continuous sheet divided into two sections along a line of separation (*page 6, lined 1-3*). It is noted that Applicant's have stated that a solid sheet has no cut lines or strips formed or removed, but can have separation lines (*specification page 24, paragraph 102 and figure 27*).

The cardstock sheet construction has a front side and a back side (*page 4, line 35*) and comprises continuous through-cut lines (*page 6, lines 10-12 and figures 1 and 6*) through the cardstock sheet construction to the back side but not through-cut through the liner sheet (*page 6, lines 1-12 and figure 1 and 6*). The through-cut lines defining at least in part perimeter edges of printable labels and of a matrix waste portion (*rim section, page 6, lines 10-12 and figures 1 and 6*).

Portions of the back side of the cardstock sheet construction are deemed to form back side surfaces of the printable business card (*rear surface of printing paper, page 4, line 35*).

The liner sheet has areas covering the back sides of all of the through-cut lines (*figure 1*). The areas are deemed to be adapted to hold the printable business cards and the matrix waste

Art Unit: 1772

portion together when the sheet of printable business cards is sheet fed through a printer or copier for the printing operation on the printable business cards (*page 6, lines 5-7 and figures 1 and 6*).

The ultraremovable adhesive covers the entirety of the back side of the cardstock sheet construction (*page 4, line 34, page 6, lines 3-5 and figure 1 and 6*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are deemed to be adapted to allow the business cards to be removed from the liner sheet and from the matrix waste portion after the printing operation into the individual printed business cards (*page 4, line 35 through page 5, line 1*).

The back side surface of the printed business cards are tack-free after removal from the liner sheet, since the reference discloses that the printing paper is releasably fixated to the support sheet (*page 4, lines 35-37*) and the adhesive coating is part of the support sheet (*page 4, line 19*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are deemed to be adapted to allow the business cards to be removed from the liner sheet and from the matrix waste portion after the printing operation into the individual printed business cards (*page 4, line 35 through page 5, line 1*) with the ultraremovable adhesive remaining on the carrier sheet and not on the back side surfaces of the printed business cards, since the reference discloses that the printing paper is releasably fixated to the support sheet (*page 4, lines 35-37*) and the adhesive coating is part of the support sheet (*page 4, line 19*). Furthermore, the printing paper may be provided with a release coating (*page 3, lines 10-17*), which would allow it to be removable to both the adhesive and the support sheet. Also see Viby page 10 lines 12-20.

The cardstock sheet construction is deemed to have a cardstock end edge, and the liner sheet is deemed to have a corresponding liner sheet end edge. Furthermore, the liner sheet end edge extends a distance out from the liner sheet edge and is deemed to form a thin end of the printable business card, since the reference discloses that the printing paper may be smaller than the support sheet (*page 3, lines 24-25*).

The preamble/limitation “business card” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, paragraph 2 and pages 4-5, paragraph 10*). Viby’s label is deemed to meet this limitation because Viby’s label is also the cut out portion of the printing paper, i.e. sheet construction (*page 6, lines 10-12 and figures 1 and 6*).

Regarding Applicant’s claim 227, Viby discloses a sheet of printable business cards (*labels, page 1, line 37 through page 2, line 5*) comprising a card stock sheet construction (*printing paper, page 4, line 35*), ultraremovable adhesive (*adhesive coating, page 4, lines 19-25*) and a continuous carrier sheet (*support sheet, page 4, line 32 and page 6, lines 1-3*) releasably secured with the ultraremovable adhesive to and covering the backside of the cardstock sheet construction (*page 3, lines 27-28, page 4, lines 35-38 and figure 1*).

Viby’s adhesive coating is deemed to be ultraremovable because it is a water based acrylic adhesive (*page 4, lines 24-25*) which is one of the preferred adhesives applicant discloses

Art Unit: 1772

(*specification page 25, paragraph 104*). It is further deemed to be an ultraremovable adhesive because, as discussed later, the adhesive remains on the carrier sheet and is not permanently attached to the card stock sheet construction.

The cardstock sheet construction has a front side and a back side (*page 4, line 35*) and comprises continuous through-cut lines (*page 6, lines 10-12 and figures 1 and 6*) through the cardstock sheet construction to the back side but not through-cut through the carrier sheet (*page 6, lines 1-12 and figure 1 and 6*). The through-cut lines defining at least in part perimeter edges of printable labels and of a matrix waste portion (*rim section, page 6, lines 10-12 and figures 1 and 6*).

Portions of the back side of the cardstock sheet construction are deemed to form back side surfaces of the printable business card (*rear surface of printing paper, page 4, line 35*).

The printable business card, the matrix waste portion, the carrier sheet, the ultraremovable adhesive and the through-cut lines are deemed to define at least in substantial part a printable business card construction.

The printable business card sheet construction being dimensioned, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business card (*page 1, line 37 through page 2, line 5*).

The carrier sheet has areas covering the back sides of all of the through-cut lines (*figure 1*). The areas are deemed to be dimensioned, constructed and adapted to hold the printable business cards and the matrix waste portion together when the printable business card sheet construction is sheet-fed through the printer or copier for the printing operation (*page 6, lines 5-7 and figures 1 and 6*).

The carrier sheet, the ultraremovable adhesive and the through-cut lines are deemed to be dimensioned, constructed and adapted to allow the printed business cards to be removed from the carrier sheet and from the matrix waste portion after the printing operation into the individual printed business cards with the ultraremovable adhesive remaining on the carrier sheet and not on the back side surfaces of the printed business cards, since the reference discloses that the printing paper is releasably fixated to the support sheet (*page 4, lines 35-37*) and the adhesive coating is part of the support sheet (*page 4, line 19*). Furthermore, the printing paper may be provided with a release coating (*page 3, lines 10-17*), which would allow it to be removable to both the adhesive and the support sheet. Also see Viby page 10 lines 12-20.

The preamble/limitation “business card” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, paragraph 2 and pages 4-5, paragraph 10*). Viby’s label is deemed to meet this limitation because Viby’s label is also the cut out portion of the printing paper, i.e. sheet construction (*page 6, lines 10-12 and figures 1 and 6*).

Regarding Applicant’s claim 228, Viby discloses that the ultraremovable adhesive covers the entirety of the back side of the cardstock sheet construction (*page 4, line 34, page 6, lines 3-5 and figure 1 and 6*).

Regarding Applicant's claim 229, Viby discloses that the carrier sheet is a solid continuous carrier, since the reference discloses that the support sheet is a continuous sheet divided into two sections along a line of separation (*page 6, lined 1-3*). It is noted that Applicant's have stated that a solid sheet has no cut lines or strips formed or removed, but can have separation lines (*specification page 24, paragraph 102 and figure 27*).

Regarding Applicant's claim 230, Viby discloses that the carrier sheet extends the entire width of the cardstock sheet construction, since the reference discloses that the support sheet and the printing paper are preferably identical in dimension (*page 3, lines 27-29*).

Regarding Applicant's claim 231, Viby discloses that adjacent ones of the printable business cards directly abut one another and share common edges (*figure 6*).

Regarding Applicant's claim 232, Viby discloses that the printable business cards are arranged in a matrix on the cardstock sheet construction (*figure 6*).

Regarding Applicant's claim 234, Viby discloses that (a) the cardstock sheet construction included left and right side edges and first and second edges, (b) the through-cut lines include frame cut lines and grid cut lines, (c) the frame cut lines include first and second side cut lines spaced in from the left and right side edges, respectively, and disposed parallel thereto, (d) the frame cut lines include first and second end cut lines spaced in from and parallel to the first and second end edges, both of the end cut lines engaging both of the side cut lines, (e) the frame cut lines define a central area on the cardstock sheet construction, (f) the grid cut lines define a grid disposed in the central area, and (g) the grid cut lines and the frame cut lines separate the central area into the printable business cards (*figure 6*).

Regarding Applicant's claim 236, Viby discloses that at least some of the through-cut lines define the matrix waste portion around the printable business cards (*figures 5 and 6*).

Regarding Applicant's claim 237, Viby discloses the through-cut lines include vertical and horizontal cut lines (*figures 3, 5 and 6*).

Regarding Applicant's claim 238, Viby discloses that the top one of the horizontal cut lines extends a full width of the cardstock sheet construction (*figure 3*).

Regarding Applicant's claim 239, Viby discloses that the ends of the rest of the horizontal cut lines are spaced inwardly from the left and right side edges of the facestock sheet construction (*figures 5 and 6*).

Regarding Applicant's claim 240, Viby discloses the rest of the horizontal cut lines extend a distance out beyond the outermost of the vertical cut lines (*figure 3*).

Regarding Applicant's claim 241, Viby discloses that the carrier sheet comprises a base paper sheet, since the reference discloses that the support sheet comes from a paper material roll (*page 6, lines 23-24*).

Regarding Applicant's claim 244, Viby discloses that the carrier sheet covers the entire back side of the cardstock sheet construction, since the reference discloses that the support sheet and the printing paper are preferably identical in dimension (*page 3, lines 27-29*).

Regarding Applicant's claim 245, Viby discloses that the through-cut lines define all of the perimeter edges of all of the printable business cards (*figures 5 and 6*).

Regarding Applicant's claim 246, Viby discloses that the printable business cards are arranged in a two column matrix on the cardstock sheet construction (*figure 6*).

Regarding Applicant's claim 247, Viby discloses that the printable business cards in each column of the two column matrix abut adjacent printable business cards in the same column separated only by respective ones of the through-cut lines (*figure 6*).

Regarding Applicant's claim 248, Viby discloses that the printable business cards comprise a matrix block of printable business cards completely surrounded by the matrix waste portion (*figure 6*).

Regarding Applicant's claim 250, Viby discloses that the printable business cards are arranged in a plurality of butt-cut columns and a plurality of butt-cut rows (*figure 6*).

Regarding Applicant's claim 252, Viby discloses that the cardstock sheet construction and carrier sheet are both rectangular and have the same width and length dimensions (*page 3, lines 18-35*).

Regarding Applicant's claim 253, the cardstock sheet construction is deemed to have a cardstock end edge, and the carrier sheet is deemed to have a corresponding carrier end edge, which is deemed to be $\frac{1}{2}$ inch wide.

Regarding Applicant's claim 256, Viby discloses that the back side surface of the printed business cards are tack-free after removal from the carrier sheet (*page 10, lines 12-19*). The labels are further deemed to be tack-free, since the reference discloses that the printing paper is releasably fixated to the support sheet (*page 4, lines 35-37*) and the adhesive coating is part of the support sheet (*page 4, line 19*).

Regarding Applicant's claim 257, Viby discloses that a cut line in the carrier sheet extends across at least substantially an entire width of the carrier sheet (*figures 3, 5 and 6*).

Regarding Applicant's claim 259, the cut line is deemed to define a printer infeed flexibility cut line of the printable business card sheet construction, since it can be seen from the figures that the cut lines are near the edges of the assembly.

Regarding Applicant's claim 262, Viby discloses that the cardstock sheet construction includes a cardstock sheet and the ultraremovable adhesive is directly on the cardstock sheet, since the reference discloses that the adhesive coating is in facial contact with the printing paper (*page 4, lines 35-38*).

Regarding Applicant's claim 265, Viby discloses that the cardstock sheet construction includes a cardstock sheet and the ultraremovable adhesive is directly on the cardstock sheet (*page 4, line 34, page 6, lines 3-5 and figure 1 and 6*).

Regarding Applicant's claim 270, the ultraremovable adhesive is deemed to provide partial contact with the cardstock sheet construction because it is a water based acrylic adhesive (*page 4, lines 24-25*), which is one of the preferred adhesives applicant discloses (*specification page 25, paragraph 104*).

Regarding Applicant's claim 271, Viby discloses that the sheet of printable business cards has A4 dimensions (*page 3, lines 30*).

Regarding Applicant's claim 272, Viby discloses that the printable business cards are arranged in a plurality of rows and a plurality of columns (*figure 6*).

Claim Rejections - 35 USC § 103

10. Claims 167, 168, 208, 209, 225 and 226 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viby in view of Hollis et al. (U.S. Patent No. 5,622,758).

Viby discloses a sheet of printable business cards (*labels, page 1, line 37 through page 2, line 5*) comprising a card stock sheet construction (*printing paper, page 4, line 35*) and a solid continuous liner sheet (*support sheet, page 4, line 32 and page 6, lines 1-3*) releasably secured with ultraremovable adhesive (*adhesive coating, page 4, lines 19-25*) to and covering the backside of the cardstock sheet construction (*page 3, lines 27-28, page 4, lines 35-38 and figure 1*).

Viby's adhesive coating is deemed to be ultraremovable because it is a water based acrylic adhesive (*page 4, lines 24-25*), which is one of the preferred adhesives applicant discloses (*specification page 25, paragraph 104*). It is further deemed to be an ultraremovable adhesive because, as discussed later, the adhesive remains on the carrier sheet and is not permanently attached to the card stock sheet construction.

Viby's support sheet is deemed to be a solid continuous liner sheet, since the reference discloses that the support sheet is a continuous sheet divided into two sections along a line of separation (*page 6, lined 1-3*). It is noted that Applicant's have stated that a solid sheet has no cut lines or strips formed or removed, but can have separation lines (*specification page 24, paragraph 102 and figure 27*).

The cardstock sheet construction has a front side and a back side (*page 4, line 35*) and comprises continuous through-cut lines (*page 6, lines 10-12 and figures 1 and 6*) through the cardstock sheet construction to the back side but not through-cut through the liner sheet (*page 6, lines 1-12 and figure 1 and 6*). The through-cut lines defining at least in part perimeter edges of printable labels and of a matrix waste portion (*rim section, page 6, lines 10-12 and figures 1 and 6*).

Art Unit: 1772

Portions of the back side of the cardstock sheet construction are deemed to form back side surfaces of the printable business card (*rear surface of printing paper, page 4, line 35*).

The liner sheet has areas covering the back sides of all of the through-cut lines (*figure 1*). The areas are deemed to be adapted to hold the printable business cards and the matrix waste portion together when the sheet of printable business cards is sheet fed through a printer or copier for the printing operation on the printable business cards (*page 6, lines 5-7 and figures 1 and 6*).

The ultraremovable adhesive covers the entirety of the back side of the cardstock sheet construction (*page 4, line 34, page 6, lines 3-5 and figure 1 and 6*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are deemed to be adapted to allow the business cards to be removed from the liner sheet and from the matrix waste portion after the printing operation into the individual printed business cards (*page 4, line 35 through page 5, line 1*).

The back side surface of the printed business cards are tack-free after removal from the liner sheet, since the reference discloses that the printing paper is releasably fixated to the support sheet (*page 4, lines 35-37*) and the adhesive coating is part of the support sheet (*page 4, line 19*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are deemed to be adapted to allow the business cards to be removed from the liner sheet and from the matrix waste portion after the printing operation into the individual printed business cards (*page 4, line 35 through page 5, line 1*) with the ultraremovable adhesive remaining on the carrier sheet and not on the back side surfaces of the printed business cards, since the reference discloses that the

Art Unit: 1772

printing paper is releasably fixated to the support sheet (*page 4, lines 35-37*) and the adhesive coating is part of the support sheet (*page 4, line 19*). Furthermore, the printing paper may be provided with a release coating (*page 3, lines 10-17*), which would allow it to be removable to both the adhesive and the support sheet. Also see Viby page 10 lines 12-20.

The cardstock sheet construction is deemed to have a cardstock end edge, and the liner sheet is deemed to have a corresponding liner sheet end edge. Furthermore, the liner sheet end edge extends a distance out from the liner sheet edge and is deemed to form a thin end of the printable business card, since the reference discloses that the printing paper may be smaller than the support sheet (*page 3, lines 24-25*).

The preamble/limitation “business card” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, paragraph 2 and pages 4-5, paragraph 10*). Viby’s label is deemed to meet this limitation because Viby’s label is also the cut out portion of the printing paper, i.e. sheet construction (*page 6, lines 10-12 and figures 1 and 6*).

Viby fails to disclose that the liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet or that the narrow exposed strip is approximately ½ inch wide.

Art Unit: 1772

Hollis discloses a label sheet comprising a backing sheet and one or more labels affixed to the backing with adhesive (*col. 5, line 62 through col. 6, line 20*). The backing sheet has a leading edge and a trailing edge that extends out to form a narrow exposed strip extending the entire width of the liner sheet (*col. 5, line 67 through col. 6, line 1 and figures 3 and 4*). The label sheet is easily loaded into machinery (*col. 4, lines 49-51*).

Viby and Hollis are analogous because they discuss printable tags/labels.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have Viby's liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet as taught by Hollis in order to make the sheet material easy to load into machinery.

The exact size of the narrow exposed strip of the liner sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as size of the narrow exposed strip, through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

11. Claims 251, 258, 263, 266 and 267 rejected under 35 U.S.C. 103(a) as being unpatentable over Viby as applied above.

Viby is relied upon as described above.

Viby further discloses that the printable business card sheet (*label system, page 3, line 18*) has dimensions in conformity with conventional paper standards (*page 3, lines 28-29*).

Art Unit: 1772

Viby fails to disclose that the printable business card sheet construction is 8.5 x 11 inches.

However, the Examiner takes Official Notice that a sheet construction having dimensions of 8.5 x 11 inches is a conventional paper standard for printers, especially desktop or home computer printers, in the United States. MPEP § 2144.03.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a card sheet construction with dimension of 8.5 x 11 inches as the conventional paper standard paper size in Viby in order to conform to US home computer printers. One of ordinary skill in the art would have been motivated to a sheet with dimensions of 8.5 x 11 inches in order to increase sales in the US to consumers with person computers.

Viby also fails to disclose that the cut line is approximately ¼ inch from an end edge of the carrier sheet.

The exact distance of the cut line to the carrier sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Viby also fails to disclose that the cardstock sheet construction is approximately 9.0 mils.

The exact thickness of the cardstock sheet construction is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a

Art Unit: 1772

result effective variable, such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

12. Claims 233, 249, 268 and 269 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viby in view of Carlson (U.S. Patent No. 5,842,722).

Viby is relied upon as described above.

Viby fails to disclose that the cardstock sheet construction is coated/glossy.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (*col. 1, lines 16-18*). The printable laminate includes die cut cards, which are coated with an ink receptive coating (*col. 19, line 50 through col. 20, line 3*). The ink receptive coating provides good ink image retention and adhesive retention (*col. 20, lines 1-3*).

Viby and Carlson are analogous because they discuss printable tags/labels.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the tag of Viby in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (*col. 20, lines 1-3*). It is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

Art Unit: 1772

Regarding Applicant's claim 269, Viby discloses that the carrier sheet comprises a base paper sheet, since the reference discloses that the support sheet comes from a paper material roll (*page 6, lines 23-24*).

13. Claims 235, 242 and 243 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viby in view of Cross (U.S. Patent No. 4,863,772).

Viby is relied upon as described above.

Viby fails to disclose that the carrier sheet is densified bleached kraft paper or the thickness of the carrier sheet.

Cross discloses label stock comprising a facestock paper, a pressure-sensitive adhesive, a layer of low density polyethylene (film), and densified bleached kraft paper release layer with a thickness of 3.1 mil (*figure 5 and col. 5, lines 1-38*).

Viby and Cross are analogous because they both discuss label/tag constructions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Cross' densified bleached kraft paper as the liner sheet of Viby, since it would have been within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, unless densified bleached kraft paper gives unexpected results. *In re Leshin*, 125 USPQ 416.

The exact thickness of the carrier sheet is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as combined thickness of layers through routine experimentation in the absence of

Art Unit: 1772

a showing of criticality in the claimed thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

14. Claims 254, 255, 260, 261 and 264 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viby in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Viby is relied upon as described above.

Viby fails to disclose that the an edge of the sheet is thinner than a body of the sheet or that the sheet is calendered.

Examiner's comment: The limitation "the printable business card sheet is calendered" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the printable business card sheet is calendered," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

Viby and Hickenbotham are analogous because they all discuss label/tag constructions.

Art Unit: 1772

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet of Viby as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing.

One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at col. 1, lines 38-51.

It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

ANSWERS TO APPLICANT'S ARGUMENTS

15. Applicant's arguments in response filed November 2, 2004 regarding the 35 U.S.C. 102 and 103 rejections of record have been considered but are moot due to the new grounds of rejection.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alicia Chevalier

2/17/05